

**FEE TRANSMITTAL****for FY 2002**

(Substitute form)

Patent fees are subject to annual revision.

Complete if Known

Application Number	09/525,041
Filing Date	Soppet, et al.
First Named Inventor	March 14, 2000
Examiner Name	Holleran, A.
Group Art Unit	1642
Attorney Docket Number	PF178D2

TECH CENTER 1600/2900

DEC 5 2001

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**METHOD OF PAYMENT**

- 1.
- ☒
- The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit Account Number **08-3425**Deposit Account Name **Human Genome Sciences, Inc.**

- ☒
- Charge Any Additional Fee Required Under 37 CFR §§ 1.16 and 1.17

☐ Applicant claims small entity status. See 37 CFR 1.27

- 2.
- ☐
- Payment Enclosed:

☐ Check ☐ Credit Card ☐ Money Order ☐ Other\***FEE CALCULATION****1. BASIC FILING FEE**

Large Entity	Small Entity	Fee Code	Fee (\$)	Fee Description	Fee Paid
		101	740	Utility filing fee	
		106	330	Design filing fee	
		107	510	Plant filing fee	
		108	740	Reissue filing fee	
		114	160	Provisional filing fee	

**SUBTOTAL (1) \$0.00****2. EXTRA CLAIM FEES**

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	-20*	\$18.00	
Multiple Dependent	-3*	\$84.00	
		\$280.00	

Large Entity	Small Entity	Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description
		103	18	203	9	Claims in excess of 20
		102	84	202	42	Independent claims in excess of 3
		104	280	204	140	Multiple dependent claim, if not paid
		108	84	209	42	** Reissue independent claims over original patent
		110	18	210	9	** Reissue claims in excess of 20 and over original patent

**SUBTOTAL (2) \$0.00**

\* or number previously paid, if greater; For Reissues, see above

**FEE CALCULATION (continued)****3. ADDITIONAL FEES**

Fee Code	Large Entity Fee (\$)	Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non-English specification	
142	1,280	242	640	Utility issue fee (or reissue)	
195	300	195	300	Publication fee for early, voluntary, or normal publication	
179	740	279	370	Request for Continued Examination (RCE)	
098	130	098	130	Processing fee, except in provisional applications	
126	180	126	180	Submission of Information Disclosure Statement	
123	50	123	50	Processing fee for provisional applications	
146	740	246	370	Filing a submission after final rejection (37 CFR 1.129(a))	
149	740	249	370	For each additional invention to be examined (37 CFR 1.129(b))	
145	100	145	100	Certificate of correction	
147	2,520	147	2,520	Request for <i>ex parte</i> reexamination	
099	8,800	099	8,800	Request for <i>inter partes</i> reexamination	
148	110	248	55	Statutory disclaimer	
115	110	215	55	Extension for reply within first month	
116	400	216	200	Extension for reply within second month	
117	920	217	460	Extension for reply within third month	
118	1,440	218	720	Extension for reply within fourth month	
128	1,960	228	980	Extension for reply within fifth month	
119	320	219	160	Notice of appeal	
120	320	220	160	Filing a brief in support of an appeal	
121	280	221	140	Request for oral hearing	
122	130	122	130	Petitions to the Commissioner	
140	110	240	55	Petition to revive unavoidably abandoned application	
141	1,280	241	640	Petition to revive unintentionally abandoned application	
091	1,280	091	1,280	Acceptance of an unintentionally delayed claim for priority	
561	3	561	3	Printed copy of patent, regular service	
581	40	481	40	Recording each patent assignment per property (times number of properties)	

Other fee (specify):

Other fee (specify):

Other fee (specify):

\* Reduced by Basic Filing Fee Paid

**SUBTOTAL (3)****\$0.00****Submitted By**

Complete (if applicable)

Name (Print/Type) **Jonathan L. Klein**Registration No.: **41,119**Telephone **301-251-6015**Signature: Date: **12/3/01**

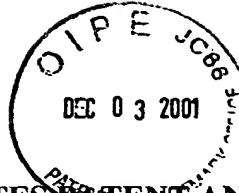
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: **Soppet, et al.**

Application No.: **09/525,041**

Art Unit: **1642**

Filed: **March 14, 2000**

Examiner: **Holleran, A.**

For: **Colon Specific Gene and Protein** Atty Docket No.: **PF178D2**

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**PROVISIONAL ELECTION WITH TRAVERSE**  
**UNDER 37 C.F.R. § 1.143**

Commissioner of Patents  
Washington, D.C. 20231

Dear Sir or Madam:

In response to the Office Action mailed November 6, 2001 please consider the following provisional election with traverse. Applicants submit concurrently herewith a Fee Transmittal Sheet.

**Provisional Election and Traverse**

The Examiner has required restriction of the claimed subject matter into one of two different groups.

In order to be fully responsive, Applicants hereby provisionally elect, with traverse, the subject matter of Group I (claims 21-37, 46-63, 72-89, 98-115, and 124). Applicants reserve the right to file one or more divisional applications directed to non-elected inventions should the restriction requirement be made final. Additionally, should the present restriction requirement be made final, Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Applicants respectfully traverse and request the withdrawal of the Restriction Requirement.

As a threshold matter, Applicants note that the Examiner has required restriction based on an assertion that the "product as claimed can be used in a materially different process of using that product." *See*, Paper No. 10, page 2, last paragraph. In particular, the Examiner asserted "the antibodies of Group I may be used in *in vivo* methods of treatment." And further, "[a]n *in vivo* method of treatment is a materially different method than the *in vitro* method of detection of an antigen." *See*, Paper No. 10, page 2, last sentence to page 3, first full sentence.

Applicants respectfully traverse.

As a threshold matter, the possibility of an alternative use alone is not sufficient to impose a restriction requirement. Applicants point out that MPEP § 803 lists the criteria for a proper restriction requirement:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 – § 806.04(i)) or distinct (MPEP § 806.05 – § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, even assuming, *arguendo*, that the groups listed by the Examiner represented distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of both groups would entail a "serious burden." *See* M.P.E.P. § 803. In the present situation, no such showing has been made.

Although the Examiner has indicated that Groups I and II are separately classified, Applicants submit that a search of the composition claims of Group I would largely overlap (and therefore provide useful information for) a search for the method claims of Group II. For example, a search for publications drawn to antibodies of the present invention would largely overlap with a search directed toward methods of detecting the protein to which said antibodies bind.

Thus, the search and examination of the composition and method claims would not entail a serious burden. Accordingly, in view of the above traverse, Applicants respectfully request that the Restriction Requirement be withdrawn so the subject matter of all the groups can be examined together.

Should the restriction requirement not be withdrawn, in order to expedite prosecution of this case, Applicants provisionally elect, *with traverse*, the subject matter of Group I represented by claims 21-37, 46-63, 72-89, 98-115, and 124.

Furthermore, if the restriction requirement is maintained, Applicants request rejoinder of the claims of Group I and II once the claims of Group I are found allowable. In light of the decisions in *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ 2d 1663 (Fed. Cir. 1996), a notice was published in the Official Gazette which set forth new guidelines for the treatment of product and process claims. See 1184 OG 86 (March 26, 1996). Specifically, the notice states that:

in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim.

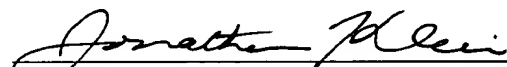
*Id.* Accordingly, if claims of Group I are found allowable, Applicants respectfully request that the claims of Group II be rejoined and examined for patentability. See also M.P.E.P. § 821.04.

### CONCLUSION

Applicants respectfully request that the remarks above be entered and made of record in the file history of the instant application.

Respectfully submitted,

Date: DECEMBER 3, 2001

  
Jonathan L. Klein (Reg. No. 41,119)  
Attorney for Applicants

**Human Genome Sciences, Inc.**  
9410 Key West Avenue  
Rockville, MD 20850  
Phone 301-251-6015

JKE/DAS/kp